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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,957	07/21/1999	RICHARD LEVY	01064.0011-0	9917

7590

01/14/2005

THE LAW OFFICES OF ROBERT J. EICHELBURG
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EXAMINER

TOOMER, CEPHIA D

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/357,957

Applicant(s)

LEVY, RICHARD

Examiner

Cephia D. Toomer

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1714

-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-32,34-43,45-50,52,53 and 55-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39,40,55,57,59,61,63,65 and 69-71 is/are allowed.
- 6) ☒ Claim(s) 29,31,32,34-38,43,52 and 53 is/are rejected.
- 7) ☒ Claim(s) 30,41,42,45-50,56,58,60,62,64 and 66-68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Pri rity under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the amendment filed September 29, 2004 in which claims 29-32, 34-43, 45-50, 52, 55, 57, 59 and 67 were amended.

The 103 rejection over Freeman in view of Le-Khac is withdrawn in view of the amendment to the claims.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 32 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 is rejected because there is no antecedent suggest in claim 31 for the recited compounds . Claim 31 is limited to carbon and metals as the inorganic lubricant.

Claim 43 is rejected because the claim is incomplete. The language following "and" is missing.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 35, 36, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,275,760) in view of Garner (from IDS of 2/03) as teaching reference.

Johnson teaches a gelled corrosion inhibitor comprising a gelling agent slurred in a first liquid medium and a corrosion inhibitor dissolved in a second liquid medium, wherein the gelling agent forms a gel in the second liquid medium (see abstract; column 3, lines 3-7). The gelling agents are water insoluble hydrogel-forming materials known in the art as super absorbent polymers (see column 3, lines 21-23, 31-68). The gelling agent is carried as a slurry in an oil such as fatty esters, mineral oils and lubricating oils (first medium). The corrosion inhibitor (lubricant additive) is dissolved in water (see column 4, lines 39-55). Johnson teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Johnson differs from the claims in that he does not specifically teach applicant's intended use. However, intended use is given no patentable weight in claims that are directed to the composition per se.

In the second aspect, Johnson differs from the claims in that he does not specifically teach that the super absorbent polymer absorbs greater than 100 times its weight in water. However, Garner teaches this difference. Garner teaches that the cross-linked neutralized poly-acrylic acid taught by Johnson absorbs 500-3000 times in weight in water (see abstract in its entirety).

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It would have been obvious to one of ordinary skill in the art to have used the claimed polymers because Johnson teaches the use of super-absorbent polymers and Garner teaches that these polymers absorb greater than 100 times their weight in water.

Claims 29, 31, 32, 35, 37, 38 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineu et al (US 4,977,192).

Martineu teaches a granular polymer composition having water absorption wherein the composition comprises a water-insoluble but swellable cross-linked polymer material formed of at least one polymer from at least one carboxylic group and at least one powdered mineral charge well dispersed in and bonded to the polymer (see claim 1). The mineral charge is mica (solid inorganic lubricant) (see claim 6). In Table IV, Martineu teaches that the polymers absorb from 100 to over 300% water.

Martineu teaches the limitations of the claims other than applicant's intended use. However, intended use is given no patentable weight in claims that are directed to the composition per se.

Claims 30, 41, 42, 45-50, 56, 58, 60, 62, 64, 66, 67 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach a lubricating composition comprising a SAP, a solid or particulate inorganic lubricant and the organic lubricant, nor does it teach the composition comprising chalcogenides of a non-noble metal.

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Claims 34, 41, 55, 57, 59, 61, 63, 65, 69, 70 and 71 are allowable because the prior art fails to teach or suggest a lubricating composition comprising the claimed SAP and a phosphate.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cepha D. Toomer
Primary Examiner
Art Unit 1714

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